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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 711

BECKMAN INSTRUMENTS, INC. and
LELAND C. CLARK, JR., *Petitioners,*

v.

CHEMTRONICS, INC. and J. RYAN NEVILLE, *Respondents.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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September 17, 1970.

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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IN THE

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v.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BECKMAN INSTRUMENTS, INC. and LELAND C. CLARK, JR., your petitioners, pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered in the above-entitled case on April 14, 1970.

OPINIONS BELOW

The findings of fact and conclusions of law of the District Court are included herein in Appendix A, *infra*, pages 2a-11a. The Fifth Circuit Opinion (Appendix A,* *infra*, pages 13a-54a) is reported at —— F.2d ——, 165 U.S.P.Q. 335 (5th Cir. 1970).

JURISDICTION

The judgment of the Fifth Circuit was entered on April 14, 1970. A timely petition for rehearing was denied on June 19, 1970. The jurisdiction of this court is invoked under 28 U.S.C. § 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. § 1338(a).

QUESTIONS PRESENTED

1. Did the Court of Appeals err in holding that this Court's decision in *United States* v. *Adams*, 383 U.S. 39 (1966), requires or permits the invalidation of a patent for an invention of such magnitude, novelty and importance that it is concededly patentable under *Adams*, because the patent claims were not limited to specified materials?

2. Did the Court of Appeals err in holding that, even in the absence of fraudulent conduct or wilful misrepresentation, there is an "uncompromising duty" to disclose prior art to the Patent Office, and that failure to do so invalidates the patent? *Cf. Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945); *Walker Process Equipment Co.* v. *Food Machinery & Chemical Co.*, 382 U.S. 172 (1965).

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* References to Appendices A, B and C are cited herein by the designation "App." followed by the letter and page number. References to the record are cited as "R." followed by the volume and page numbers in the printed record prepared for the Court of Appeals.

3. In view of the differences among the Circuits, should this Court grant certiorari to resolve and settle the questions presented?

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and §§ 101, 102 and 103 of the Patent Code of 1952, 35 U.S.C. §§ 101, 102 and 103. These provisions are set forth in Appendix B, beginning at page 1b, *infra*.

STATEMENT

A. SUMMARY OF PROCEEDINGS.

Beckman Instruments, Inc. and Leland C. Clark, Jr., ("petitioners") sued Chemtronics, Inc. and J. Ryan Neville ("respondents") for infringement of their U.S. Patent No. 2,913,386 (the "Clark patent"), issued in 1959. The patented device was and is of the utmost importance to medical science. It provided a long sought after instrument for measuring the concentration of oxygen in the blood stream and other media. This is of the greatest importance to research in the physiology of the heart and brain and in various procedures incident to the treatment of circulatory ailments.

Respondents counterclaimed alleging non-infringement, invalidity, fraud in the procurement of the patent, and anti-trust violations flowing from the alleged fraudulent procurement. Trial was held beginning June 17, 1968. After hearing extensive evidence, the District Court found that the Clark patent was valid, and that petitioners were not guilty of fraud or bad faith. (App. 2a-11a) It concluded, however, that re-

spondents had not infringed the Clark patent.[1] Accordingly, it dismissed the complaint as well as the counterclaim. (App. 1a) Both sides appealed.

On appeal, the Fifth Circuit affirmed the dismissal of Petitioners' complaint and remanded the case for further evidence with respect to Respondents' counterclaim. It did not consider the issue of non-infringement upon which the District Court's decision turned. Instead, it held that although the Clark invention was patentable under this Court's decision in *United States v. Adams*, *supra*, the Clark patent was invalid because, as it viewed the requirements of law, the claims sued upon had been anticipated by the publication by Stow in 1954 of a device for measuring carbon dioxide concentrations in liquid, and because petitioners had failed to fulfill an "uncompromising duty" of advising the Patent Office of the Stow publication. (App. 19a). It made no finding that the patent had been procured by fraud or willful misrepresentation, but on the contrary, it instructed the District Court on remand, in connection with the antitrust counterclaim, to examine "the *evidence* to determine whether appellants indulged in knowing, wilful misrepresentation of material facts" to the Patent Office.[2] (App. 35a).

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[1] Petitioners had contended that respondents' self-energized devices were polarographic and that they infringed claims 9 and 10 of the Clark patent. Respondents denied that their devices were polarographic or were covered by these claims of the Clark patent. The Trial Court held that petitioners' patent claims were too narrow to cover respondents' devices. (App. 10a, Findings 28-30). For full text of claims 9 and 10, see App. C.

[2] The court said: "Our holding above, that appellants did not fulfill an 'uncompromising duty' of frank disclosure, is all that is required for us to dispose of the issues properly before us. It does not fully answer the question whether appellants engaged in willful and knowing misrepresentations of material facts." (App. 35a n.27).

B. THE INVENTION AND ASSERTED PRIOR ART

1. The Invention.

The Court of Appeals does not challenge the fact that Dr. Clark's device was a novel, patentable invention which constituted a sharp breakthrough in a difficult, abstruse and complex art. (App. 20a).

Dr. Clark is a famed scientist and inventor.[3] He had worked extensively on the problem of measuring blood oxygen or "oxygen tension." As the Fifth Circuit conceded, "Many others were attempting to make the same measurement; the problem had, in fact, confronted the scientific community for some time." (App. 18a). Despite the existence and general knowledge of the Stow device, as the court below stated, "the blood oxygen problem had previously [before Clark's invention] evaded solution."[4] (App. 20a).

The application for patent covering Clark's invention was filed on March 21, 1956. The patent issued on November 17, 1959. (App. 3a) The Court of Appeals recognized "the undeniable commercial success of the device * * * and the subsequent acclaim the de-

[3] Dr. Clark was instrumental in the development of the heart-lung machine. He is the author or co-author of over 150 papers in biochemistry, physiology, electrochemistry and polarography. He has conducted intensive research relating to the physiology of the heart and brain. (R. Vol. I p. 139, Vol. II p. 141).

[4] Dr. Severinghaus, whose deposition is in evidence, is one of the recognized scientists who worked on the problem. Dr. Severinghaus was unable to solve the blood-oxygen problem although his work with the Stow device was so intensive that the Stow device is now referred to as the Severinghaus cell.

In 1957, Dr. Severinghaus called a conference of scientists in the hope of finding an answer to the problem of measuring oxygen in blood. At this conference, Dr. Clark disclosed his invention and the meeting was promptly adjourned, its purpose having been dramatically fulfilled. (R. Vol. II pp. 192-193, 203).

vice was accorded." (App. 20a) In fact, it was and is today recognized as a major breakthrough of the greatest importance to medicine and medical science.[5] Accordingly, the Court of Appeals, recognizing the force of this Court's holding in *United States* v. *Adams*, *supra*, "assume[s]" that the Clark invention was patentable under that case, but it misunderstands the principle of *Adams* that it is the quality of the invention that matters, and arrives at the strange conclusion that the patent was invalid as anticipated by the Stow device. (App. 19a).

2. Clark's Invention and the Stow Device.

Dr. Clark's invention may be described as follows: He used a cell within which two metallic ~~electrodes—anode (positive) and cathode (negative)—~~ were placed. These electrodes were immersed in an electrolyte (a liquid which is a conductor of electricity) and both the electrodes and the electrolyte were shielded behind a semi-permeable membrane. Oxygen but not blood could pass through this membrane into the electrolyte. In so doing, the oxygen caused a flow of electricity. The measurement of this electrical current enables the technician to detect the concentration of oxygen in the blood.

Stow's device, like Clark's, involves the measurement of a sample by means of a cell containing two elec-

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[5] For example, noted scientist D. W. Lubbers, in chronicling the efforts of the scientific community to solve the problem of measuring oxygen tension by polarographic analysis, concluded: "All together it took 60 years before Clark (1956) succeeded in constructing the membrane covered Pt-electrode which today enables us to measure the oxygen tension of blood in routine work." (R. Vol. IV, p. 93).

trodes within a permeable membrane; but there the similarity ends.

(1) Stow's device measures carbon dioxide; it cannot be used to measure oxygen. (App. 18a; R. Vol. I, p. 111).

(2) Stow's device is in a different methodological field. It is in the field of "potentiometric analysis, which involves measure of voltage, rather than in polarography, which involves measurement of current."[6] (App. 26a).

(3) Stow's device "does not and cannot permit the flow of any significant (electric) current." (App. 7a). Clark's invention requires and depends upon the flow of electric current. (App. 3a, 24a, n. 12).

(4) Stow's device uses a glass, non-conducting electrode which does not permit the flow-through of any significant electric current. (App. 7a) Clark uses an electrode of platinum or, as his patent teaches, some other suitable metal for the conduction of electric current. (R. Vol. II, p. 204).

These differences between Clark's invention and the prior art, achieving as they did a result which had long evaded intensive scientific effort, would seem to place the invention securely within the ambit of *United States* v. *Adams*, *supra*. The Court of Appeals conceded that *Adams* would require patentability of Clark's invention "even after Stow" because of Clark's undoubtedly "novel solution" of an important problem. But the Court nevertheless holds that Clark's patent is

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[6] "The invention [Stow's] as he actually constructed it was not within the realm of polarography, but rather concerned a related field called *potentiometric* analysis." (App. 17a-18a).

invalid because the claims sued upon are too general: that is, because they were not drafted in terms of any "set of materials." (App. 27a) As the Court said, "It is this fact, and not want of invention, that invalidates the patent." (App. 20a, n. 8) For this reason, the Court holds that the patent is invalid as anticipated by Stow. (App. 19a, 34a, n. 26).

This is obviously an attempt to limit *Adams* by distorted interpretation, which *Adams* itself rejects, of the doctrine of anticipation. Clearly, on the court's own findings, Stow did not "anticipate" Clark.[7] They related to different fields, were useful with respect to entirely distinct problems, and used different materials and principles.

Adams stands for the important and basic principle that the novelty and magnitude of the inventive act determines patentability. It was the clear statement of this principle in *Adams* that elevates that decision to a landmark case. It requires that the reality of the invention, its scope, contribution, and true inventiveness, should govern the question of patentability, and not the small and contrived intricacies which have in the past been so often used to grant or deny patentability.

Adams is conclusive that Stow cannot be deemed to preclude the Clark patent. In *Adams*, the field of the invention was crowded. Wet batteries were old in the art. But *Adams* invented a battery which for the first time was water-activated and which was capable of pro-

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[7] 35 U.S.C. §§ 101, 102; *Topliff* v. *Topliff*, 145 U.S. 156, 161 (1892); *Ling-Temco-Vought, Inc.* v. *Kollsman Instrument Corp.*, 372 F. 2d 263, 267 (2d Cir. 1967).

ducing sustained current.[8] This Court affirmed the patentability of the *Adams* invention because of its novel and "unexpected" result which was of great importance and utility.

This is precisely the situation in the present case. The fact that the *Adams'* claims were limited to specific materials is not significant. These specified materials were essential to *Adams'* invention, and no other materials could be used. On the other hand, Clark's invention did not depend upon the use of any one material; as the patent taught, a variety of materials could be used within the described technique to accomplish different purposes within the field of polarography. For example, different types of metals, as we have described, and different types of membranes could be used, depending on the sample to be measured and the specific problem. The claims sued on, however, were specifically limited, as the Court of Appeals recognized, to the field of polarography. (App. 23a) This limitation as well as the fundamental and specific differences to which we have referred made it impossible, contrary to the court's surprising statement,[9] for the claims to embrace the Stow device or any development of it because Stow is restricted in its application to the

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[8] "We conclude the Adams battery was also nonobvious. As we have seen, the operating characteristics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing wet batteries * * * Nor are these the only factors bearing on the question of obviousness. We have seen that at the time Adams perfected his invention noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of the Adams invention . . ." *United States* v. *Adams*, 383 U.S. 39, 51-52 (1966).

[9] ". . . we find it to be identical to Stow's prior invention and simply put to a different use." (App. 22a).

completely distinct field of potentiometry, is directed to different purposes, and is dependent upon different principles and materials.

There is no requirement in *Adams* or elsewhere in the law that patent claims be limited to specific particularized materials or processes, or that they be differentiated from prior art by this specific means if all other requirements are met.

It is true, of course, that there are some similarities between the Stow device and the Clark invention. The Fifth Circuit holds that *only* the similarities are relevant to the question of anticipation. It says "It is likewise true that there are important differences between these two analytical processes; but there are also important similarities, and it is the similarities that are relevant here." (App. 26a) This view, that the existence of similarities determines anticipation, regardless of the magnitude and novelty of the subsequent inventive act, is clearly contrary to *Adams*, to the entirety of patent law and to common sense.

It is the claimed invention as a whole that must be considered. As this Court said in *Graham* v. *John Deere Co.*, 383 U.S. 1, 12 (1966), in discussing the basic principles laid down in *Hotchkiss* v. *Greenwood*, 11 How. 248, 13 L.Ed. 683 (1851):

> "The *Hotchkiss* formulation, however, lies not in any label, but in its functional approach to questions of patentability. In practice, *Hotchkiss* has required a comparison between the subject matter of the patent, or patent application, and the background skill of the calling. It has been from this comparison that patentability was in each case determined."

The Fifth Circuit's decision in this case will result in "forum shopping" and in proliferation of litigation. It is at variance with the views of other circuits as well as the plain meaning of this Court's decision. In *Egan & Co.* v. *Modern Plastic Machinery Corp.*, 387 F.2d 319 (3rd Cir. 1968), the Third Circuit upheld patentability (reversing the District Court) and recognized that this Court's conclusion in *Adams* was induced by the realistic fact that the invention represented a significant advance in the field, filled a long felt but unsolved need and presented a solution which had evaded others working in the field. 387 F.2d at pp. 323-324. See, also, *Jones Knitting Corporation* v. *Morgan*, 361 F.2d 451, 458 (3rd Cir. 1966).[10]

C. THE NON-DISCLOSURE ISSUE.

The Court of Appeals, as an "independent" ground for finding the Clark patent invalid, held that petitioners "failed to fulfill the 'uncompromising duty' of disclosure" before the Patent Office. (App. 19a) No court has ever before held that there is an absolute duty to cite prior art to the Patent Office. The Court of Appeals specifically did *not* make a finding of fraud in the sense in which this Court has defined it in *Precision Instrument Manufacturing Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945) and *Walker Process Equipment Co.* v. *Food Machinery & Chemical Company*, 382 U.S. 172 (1965). (App. 35a n.27) Both of these cases involve conscious and intentional fraud. *Precision Instrument* involved perjured affidavits in patent interference proceedings. *Walker*

[10] In *L. & A. Products, Inc.* v. *Britt Tech Corp.*, 365 F.2d 83, 85-86 (8th Cir. 1966), the Eighth Circuit, although denying patentability, recognized that *Adams* required that a patent be sustained where it resolved "baffling problems" in a novel, useful and non-obvious manner.

Process involved intentional misrepresentation to the Patent Office that the invention had not been in public use in the United States for more than one year prior to the application.

This Court has never decided whether, in any circumstances, there is a duty of disclosure of prior art in the prosecution of patent applications, much less what its scope and implications should be. No other Court of Appeals has held applicants to a standard comparable to that announced in this case.

Various circuits have advanced alternative standards. A standard frequently cited is that enunciated by Judge Wyzanski in *United States* v. *Standard Electric Time Co.*, 155 F. Supp. 949, 952 (D. Mass. 1957), app. dismissed, 254 F.2d 598 (1st Cir. 1958). Judge Wyzanski held that if "*every* reasonable man" would say that the invention claimed had been anticipated by a publication known to the inventor, the inventor would have been obligated to disclose his knowledge to the Patent Office. (Emphasis supplied)

This standard was followed by the Seventh Circuit in *Wen Products Inc.* v. *Portable Electric Tools, Inc.*, 367 F.2d 764 (7th Cir. 1966). In the recent case of *Mercantile National Bank of Chicago* v. *Quest, Inc.*, 303 F. Supp. 926 (N.D. Ind. 1969); aff'd. —— F.2d ——, (7th Cir. 1970), slip opinion No. 17694, filed Aug. 13, the court affirmed a District Court holding that ": . . where prior art known to the patentee does not anticipate the subject matter of the invention, there is no obligation to call such prior art to the attention of the patent examiner." (303 F. Supp. at p. 933).

The Tenth Circuit applies a somewhat differently phrased requirement. In *Admiral Corp.* v. *Zenith Radio Corp.*, 296 F.2d 708, 716 (10th Cir. 1961), the

applicant is admonished to cite prior art which "*a* reasonable man" would consider an anticipation. (Emphasis supplied)"

The Ninth Circuit rephrased the *Admiral* rule, concluding that "undisputably and obviously relevant" prior art must be disclosed. *Duff-Norton Co. v. Ratcliff*, 362 F.2d 551, 553 (9th Cir. 1966).

In the Fourth Circuit, *Technograph Printed Circuits Ltd. v. Bendix Aviation Corp.*, 218 F. Supp. 1, 46-47 (D. Md. 1963), aff'd 327 F.2d 497 (4th Cir. 1964), suggests that applicants might be required to cite only references more pertinent than those already cited by the examiner.

In the recent Second Circuit case of *Indiana General Corp. v. Krystinel Corp.*, —— F.2d ——, 164 U.S.P.Q. 321, 329, 330 (2d Cir. 1970), the applicant failed to cite prior art which was stated to be so relevant that upon its citation "the proceedings might have ended abruptedly in final rejection of the applicaiton." Yet attorneys' fees were denied upon the basis that the evidence was sufficient to support "a bona fide belief in the patent's validity." [11]

The Court of Appeals does not purport to apply any of these standards. Instead, at variance with all other

[11] There also is great variety and uncertainty as to the sanctions to be imposed once the finding is made. As noted hereafter, it is settled that failure to cite prior art may result in a loss of the presumption of validity as to that art. In addition, sanctions range from the unique holding of the Fifth Circuit in the present case—that is, a judgment of invalidity of the patent for failure to cite a prior publication—to award of attorneys' fees, *Monolith Portland Midwest Co. v. Kaiser Aluminum and Chemical Corp.*, 267 F. Supp. 726, 787 (S.D. Cal. 1966), mod. and aff'd. 407 F.2d 288, 293-94 (9th Cir. 1969), compulsory licensing, *Charles Pfizer & Co. v. F.T.C.*, 401 F.2d 574, 586 (6th Cir. 1968), and unenforceability of the patent in the particular case, *Minnesota Mining & Mfg. Co. v. Projection Optics Co.*, 256 F. Supp. 354 (W.D.N.Y. 1966).

courts that have considered the matter, it announces a rule of "uncompromising duty"[12] to reveal prior art.

This "rule", we submit, is based upon a misunderstanding of Patent Office theory and practice.

1. Non-Disclosure of Prior Art in Patent Office Practice.

The rule imposed in the present case by the Fifth Circuit would have the effect of placing upon applicants a burden which was never contemplated by the patent system. Our system, like all other major patent systems throughout the world, except France which has a "registration" system, is an "examiner" type of pre-screening system. It is designed to encourage the public disclosure of inventions through the filing of patent applications without placing the burden and responsibility for prior art investigation upon the inventor. The burden of search is assumed by the government. The Patent Office is supposed to screen applications and to eliminate the unqualified, to the best of its ability.[13] In instances of controversy, the final judgment is to be made by the courts in adversary proceedings.

In the 1950's when Clark's patent was presented, the citation of prior art was not the usual practice. The applicant and his counsel theoretically had a choice of citing or not citing prior art. If the applicant did not cite a prior, related patent or publication, he took the risk that the Examiner might not refer to it. If so, the applicant would not have the benefit of the presumption

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[12] This phrase is derived from Justice Murphy's opinion in *Precision Instrument*, but Justice Murphy was not referring to the difficult and complex question of the need to cite prior art. He was speaking solely of "fraud or inequitableness" such as the filing of false affidavits. 324 U.S. at *p.* 818.

[13] Amdur, PATENT FUNDAMENTALS, 85-86 (1st Ed. 1948).

of validity to which a patent is entitled as against prior art which has been cited and considered.[14]

Only recently, beginning in 1963, has consideration been given to a change in this system.

2. A Rule of Prior Art Disclosure Has Been Considered by the Patent Office and the Congress, But Has Never Been Adopted.

In 1963, the Patent Office proposed an amendment to its rules to require citation of prior art by the applicant, 28 Fed. Reg. 7513 (1963). Because of complexities and disadvantages which became evident upon further consideration of the rule, the Patent Office, on December 10, 1963, announced the rejection of the rule but encouraged applicants voluntarily to cite prior art. The Commissioner stated that the purpose of such voluntary citation was not to replace the work of the Examiner, but to provide a check and to facilitate his search. 797 Official Gazette of the U.S. Patent Office 733 (1963).

On May 19, 1964, the Official Gazette recited that despite the rule encouraging prior art, *only 10% of the cases filed included such citations*. 802 Official Gazette of the U.S. Patent Office 601 (1964). Even so, one of the difficulties of the problem is illustrated by the fact that in 1967, the Patent Office was so inundated with prior art citations in those relatively few applications

[14] "The Patent Office makes a conscious effort to place the most pertinent prior art into the record" (Seidel, What the General Practitioner Should Know About the Patent Law and Practice, 57 [2d Ed. 1966]) and to consider it. But if the Office does not cite a particular reference and if the applicant did not know of it or chose not to cite it, the penalty is the loss of the presumption. *Hobbs* v. *Wisconsin Power & Light Co.*, 250 F.2d 100, 105 (7th Cir. 1957).

where prior art was cited, that it had to place a limit of five citations per patent. 846 Official Gazette of the Patent Office 688, (1968).

At the present time, the question whether prior art citation should be required, and if so, in what manner, remains a matter of debate and uncertainty. The Congress, the Bar, and the Patent Office currently are considering proposals to deal with the subject.[15]

Although at first glance the matter may appear simple and non-involved, the citation of prior art to the Patent Office is fraught with difficulty. If an applicant is required to cite *all* prior art, as the Court of Appeals holds in this case, the Patent Office would be totally inundated by the obligation to examine the references at peril of being held to have considered and passed upon them. If only those publications and patents in the prior art must be cited, which applicant himself, in good faith, considers to be most closely anticipatory, equal difficulties are apparent.

It is interesting and illuminating to note that pending proposals circumscribe the obligation to cite prior art in some manner, and in varying forms, they specifically provide, contrary to the absolute rule of the present case, that failure to cite a prior patent or publication because of a matter of judgment or inadvertence shall not invalidate the patent or be considered fraud.[16]

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[15] See, e.g., Proposed Amendment to Patent Rules of Practice, 37 CFR § 1.98 (1970); S. 2756, 91st Cong., 1st Sess. § 131(e); American Patent Law Association Special Committee to Study the Patent System, Final Report (July 14, 1966).

[16] e.g., "Neither matters of judgment in identifying patents, publications, or any other prior art, whether or not required by this section, nor inadvertent failure to comply with the provisions of this section shall be grounds for refusing to issue a patent." Proposed amendment to 37 CFR 1.98(e) (1969).

3. There Was No Duty To Disclose the Stow Prior Art in This Case.

Without doubt, "wilful and knowing misrepresentation of material facts" to the Patent Office, or wilful and knowing withholding of information as to fraudulent or unequitable conduct, such as when affidavits filed are materially false and prejured, will deprive a patentee of power to enforce the riglits derived from his patent. No such finding has been made in the present case.

The District Court found that the applicants had not, either deliberately or in bad faith, "withheld from the Patent Office knowledge of the prior Clark and Stow work. The record does not support any finding of bad faith on the part of the plaintiffs." (App. 8a).

The Court of Appeals did not make a finding as to "whether appellants engaged in willful and knowing misrepresentations of material facts." (App. 35a, n.27) It vaguely and generally refers to "affirmative representations" that there were no previous devices displaying the properties of the Clark invention (App. 31a) This, of course, was and is the opinion and conviction of the applicant; it was and has been the opinion of the scientific and medical community in general; and it was the finding and conclusion of the Trial Court.

The Court of Appeals was obviously disturbed by a memorandum written on December 6, 1956, by a Beckman employee, Mr. Strickler, relating to the Clark application. Shortly after the application was filed, Strickler addressing himself to the application as it *then* appeared, wrote that the Stow device, with which Beckman was familiar, was "clearly within the scope

of claims *now* in the Clark application. * * * We do not at the present time know whether Clark or Stow is the prior inventor as concerns the *broad claims* of the Clark application." (App. 31a). (Emphasis supplied).

All of the broad claims in the application at the time of this memorandum were cancelled (R. Vol. V, pp. 168, 195) and the claims asserted in this litigation were specifically confined to the field of polarography. Nevertheless, the Court of Appeals construes Strickler's memorandum as evidence that Beckman had rights "in a device that it had reason to believe was not patentable." (App. 31a) This is entirely unjustified.

In the first place, Strickler was speaking of the Clark application in an early form which did not confine its claims to polarography. As thereafter modified and refined, claims for the Clark invention, as the Court of Appeals acknowledged, were restricted to that field. Secondly, there would be in any event no reason to charge the Beckman company—or Dr. Clark—with the reactions of a single individual whose views were not final or definitive. Diverse views of this sort exist with respect to almost all decisions. Certainly, there is no evidence in this record and no finding that the corporate officers and counsel, responsible for the ultimate decision, or Dr. Clark, believed that the Clark invention was "not patentable."

We repeat that the Court of Appeals did not find that Petitioners were guilty of fraud on the Patent

Office. This issue was referred to the District Court on remand. Rather, it held that they failed to include certain material in their presentation to the Patent Office which neither existing law or practice required.

4. The Court of Appeals Decision Threatens the Validity of Patents Obtained in Good Faith.

A judicial rule requiring prior art citation, operating retrospectively as well as prospectively, would have a devastating effect on our patent system and upon our economy. Most of the hundreds of thousands of patents issued since 1954 are still outstanding. Prior to 1963, relatively few patent applicants cited any prior art. Surely these inventions did not occur in fields totally devoid of relevant prior art references.[17]

Petitioners calculate that there are hundreds of thousands of patents in which applicants cited no prior art and which may be subject to attack for failure to comply with the "uncompromising duty" engrafted by the Court of Appeals in this case. Holders of these patents, like your petitioners, prosecuted their patent applications relying in good faith on rules of practice which did not require prior art citation in situations like those of the present case.

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[17] In the *Adams* case, for example, this Court recognized that "the Patent Office found not one reference to cite against the Adams application" [and Adams cited none] although much related art existed. 383 U.S. at p. 52.

CONCLUSION

Because the decision below is at sharp variance with a recent decision of this Court, because it decides issues in which there are contradictory opinions among the Circuits, and because of the importance of the issues:

We respectfully submit that the Court should grant Petitioners' prayer for a Writ of Certiorari.

Respectfully submitted,

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September 17, 1970.